

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

SYMBOL TECHNOLOGIES, INC.,            )  
  )  
          Plaintiff,                    )  
  )  
          v.                            )    C.A. No. 01-801-SLR  
  )  
PROXIM INCORPORATED,                )  
  )  
          Defendant.                  )

---

Andre G. Bouchard, Esquire and Karen L. Pascale, Esquire of Bouchard, Margules & Friedlander, Wilmington, Delaware. Counsel for Plaintiff. Of counsel: Eric J. Lobenfeld, Esquire, Ira J. Schaefer, Esquire, Jonathan M. Sobel, Esquire, Sophia Tsokos, Esquire and Ernest Yakob, Esquire of Clifford, Chance, Rogers & Wells, LLP, New York, New York.

Richard L. Horwitz, Esquire of Potter, Anderson & Corroon, LLP, Wilmington, Delaware. Counsel for Defendant. Of counsel: Harry J. Roper, Esquire, Raymond N. Nimrod, Esquire and Aaron A. Barlow, Esquire of Roper & Quigg, Chicago, Illinois.

---

**MEMORANDUM OPINION**

Dated: January 29, 2003  
Wilmington, Delaware

**ROBINSON, Chief Judge**

**I. INTRODUCTION**

On December 4, 2001, plaintiff Symbol Technologies, Incorporated ("Symbol") filed this action against defendant Proxim, Incorporated ("Proxim") alleging infringement of four U.S. Patents owned by plaintiff. On December 18, 2001, Proxim answered the complaint and asserted a number of counterclaims. Presently before the court is plaintiff's motion to dismiss defendant's seventh and eighth counterclaims (D.I. 59), defendant's motion to amend its answer and add a counterclaim (D.I. 60), and plaintiff's motion to dismiss this action with respect to U.S. Patent No. 5,668,803 ("the '803 patent") (D.I. 69). This court has jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338.

**II. STANDARD OF REVIEW**

In analyzing a motion to dismiss pursuant to Rule 12(b)(6), the court must accept as true all material allegations of the complaint and it must construe the complaint in favor of the plaintiff. See Trump Hotels & Casino Resorts, Inc. v. Mirage Resorts, Inc., 140 F.3d 478, 483 (3d Cir. 1998). "A complaint should be dismissed only if, after accepting as true all of the facts alleged in the complaint, and drawing all reasonable inferences in the plaintiff's favor, no relief could be granted under any set of facts consistent with the allegations of the complaint." Id. Claims may be dismissed pursuant to a Rule

12(b)(6) motion only if the plaintiff cannot demonstrate any set of facts that would entitle him to relief. See Conley v. Gibson, 355 U.S. 41, 45-46 (1957). The moving party has the burden of persuasion. See Kehr Packages, Inc. v. Fidelcor, Inc., 926 F.2d 1406, 1409 (3d Cir. 1991).

### **III. DISCUSSION**

#### **A. Plaintiff's Motion to Dismiss Defendant's Seventh and Eighth Counterclaims**

Defendant's seventh and eighth counterclaims stem from a May 1, 2001 press release by plaintiff, which allegedly caused harm to defendant. The counterclaims allege unfair competition under the Lanham Act and state law unfair competition and tortious interference, respectively. On July 24, 2002, the court denied plaintiff's first motion to dismiss these counterclaims stating that based on the record presented, dismissal was improper.

(D.I. 40) The court concluded that "the record indicates at this juncture that plaintiff did not merely restate the allegations made in the complaint at bar, but broadened its allegations of wrongdoing well outside the scope of this litigation." Id. at 4.

In its renewed motion to dismiss, plaintiff makes many of the same arguments it did in its original motion. It argues essentially that defendant's allegations are conclusory and unsupported in fact. However, plaintiff fails to appreciate that in analyzing a motion to dismiss, the court must accept defendant's factual allegations as true and draw all reasonable

inferences in its favor. While plaintiff's arguments may be persuasive in the context of summary judgment, defendant has alleged enough facts to survive a motion to dismiss. Therefore, plaintiff's motion shall be denied.

**B. Plaintiff's Motion to Dismiss the Action With Respect to the '803 Patent**

Plaintiff states that in light of recently discovered prior art, it realized its '803 patent is invalid under 35 U.S.C. § 102(b). (D.I. 70 at 4) Therefore, plaintiff filed a statutory disclaimer with the United States Patent and Trademark Office disclaiming all claims of the '803 patent. (Id.) Plaintiff now seeks to dismiss this action with respect to the '803 patent. Since the claims of the '803 patent have been disclaimed, there is no longer a case or controversy over the '803 infringement action. Therefore, the court no longer has subject matter jurisdiction and plaintiff's motion shall be granted.

In its answering brief, defendant expresses concern that plaintiff's dismissal of the '803 claims may be used by plaintiff to try to preclude defendant from pursuing its seventh and eighth counterclaims. The court notes that although the action with respect to the '803 patent has been dismissed, plaintiff's actions with respect to the '803 patent may still be relevant to defendant's seventh and eighth counterclaim, and the dismissal does not affect defendant's ability to pursue these claims.

**C. Defendant's Motion to Amend its Complaint**

Defendant seeks leave to amend its complaint to include an additional affirmative defense of inequitable conduct with respect to the '803 patent and to amend its fourth counterclaim to seek a declaratory judgment that the '803 patent is unenforceable due to inequitable conduct. (D.I. 60) Given the court's ruling above, defendant's motion to amend is denied as moot.

#### **IV. CONCLUSION**

For the aforementioned reasons, plaintiff's motion to dismiss defendant's seventh and eighth counterclaims is denied, defendant's motion to amend its answer and add a counterclaim is denied as moot, and plaintiff's motion to dismiss this action with respect to the '803 patent is granted. An appropriate order shall issue.

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

SYMBOL TECHNOLOGIES, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 01-801-SLR
	)	
PROXIM INCORPORATED,	)	
	)	
Defendant.	)	

**O R D E R**

At Wilmington, this 29th day of January, 2003, consistent with the Memorandum Opinion issued this same day;

IT IS ORDERED that:

1. Plaintiff's motion to dismiss defendant's seventh and eighth counterclaims (D.I. 59) is denied.
2. Defendant's motion to amend its answer and add a counterclaim (D.I. 60) is denied as moot.
3. Plaintiff's motion to dismiss this action with respect to the '803 patent (D.I. 69) is granted.

Sue L. Robinson  
United States District Judge